

REMARKS

Thorough examination of the application is sincerely appreciated.

The title of the invention is replaced with a new title. Entry of the new title is requested into the record.

It is not clear what material is allegedly incorporated by reference according to the Office Action, as Applicant's representative cannot find the "incorporated by reference" statement anywhere in the instant specification and, in particular, with reference to "ISO/IEC International Standard 13818-6, 'MPEG-2 Digital Storage Media Command and Control' July 12, 1996," as asserted by the examiner. If the examiner maintains the objection, clarification is requested. Otherwise, withdrawal of the objection is warranted.

With respect to the drawings, it is acknowledged that formal drawings will be submitted upon allowance of the application.

According to the Office Action, claim 12 was rejected under 35 USC 112, first paragraph. The rejection is respectfully traversed. It is respectfully submitted that the examiner cannot reject claims under 35 USC 112, first paragraph, which refers to the specification. The rejection to the claim is improper and must be withdrawn.

If the examiner objects to the specification for failing to provide support for the subject matter recited in claim 12, he is requested to refer to page 6, line 29 through page 7, line 2 of the instant specification for such a disclosure. If the examiner still disagrees and maintains the so-called rejection, he is respectfully requested to provide – **for Applicant's review and rebuttal** – an affidavit from a skilled artisan stating that an undue experimentation is required to practice the invention, as recited in claim 12, in light of Applicant's disclosure.

According to the Office Action, claim 14 was rejected under 35 USC 112, second paragraph. The rejection is respectfully traversed. It is respectfully submitted that a version number refers to a module. Applicant's representative rejects the examiner's implication or obfuscation that a version number has to be associated with hardware or software. The examiner is respectfully requested to review page 7, lines 3-6 of the instant specification for clarification. If the examiner still disagrees and maintains the rejection, he is respectfully requested to provide – **for Applicant's review and rebuttal** – either a personal affidavit or an affidavit from a skilled artisan stating that a version number must be attached to hardware or software in light of Applicant's disclosure.

According to the Office Action, claims 7 and 8 were rejected under 35 USC 101. In response, Applicant amends claim 7 without conceding any statements or waiving any arguments in the Office Action. Withdrawal of the rejection is respectfully requested.

If the examiner still disagrees and maintains the rejection of claims 7 and 8 under 35 USC 101, he is respectfully requested to review the following cases for clarification: In re Warmerdam, 33 F.3d 1354 (Fed. Cir. 1994), In re Lowry, 32 F.3d 1579 (Fed. Cir. 1994), In re Beauregard, 53 F.3d 1583 (Fed. Cir. 1995), and the USPTO Guidelines on the statutory subject matter under 35 USC 101.

According to the Office Action, claims 1-11 and 13 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,420,866 (hereinafter "Wasilewski") in view of U.S. Patent US 5,734,589 (hereinafter "Kostreski").

In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a prima facie case of obviousness in accordance with the established cases and statutory law.

In the Office Action, the Examiner conceded that Wasilewski was deficient in teaching or suggesting the feature of “a carousel having a plurality of modules each comprising at least one object,” as recited in Applicants’ claim 1.

To cure the above deficiency, the examiner turned to Kostreski for allegedly disclosing the above feature of Applicants’ invention. For such disclosure, the examiner relied on Kostreski’s col. 5, line 33 through col. 6, line 6.

Applicant’s representative has carefully reviewed Kostreski and the portions of the patent relied upon in the Office Action. It is respectfully submitted that the examiner merely extracted a data carousel feature from Kostreski and inserted it into Wasilewski, while completely disregarding the individual objectives of each patent.

It is respectfully submitted that the Examiner failed to establish a *prima facie* case of obviousness. The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Analyzing the references according to the above roadmap, first the examiner offered an unsupported, conclusory remark that “it would have been obvious ...” It is not clear what the basis was for such an assertion. There is absolutely no motivation or suggestion to combine the references, except on the basis of the impermissible hindsight and knowledge gleaned from Applicants’ invention. Such a practice is prohibited by the applicable law and cannot possibly be sanctioned by the USPTO. Picking and choosing elements from various references, while disregarding each reference as a whole, is clearly prohibited by the courts and cannot possibly be sanctioned by the USPTO.

Second, the examiner failed to indicate a reasonable expectation of success and whether the prior art references are combinable.

Third, Wasilewski and Kostreski, even when combined, do not teach all of the Applicant’s features as recited in claim 1: there is no disclosure in Kostreski of “a carousel having a plurality of modules each comprising at least one object” as recited in Applicant’s claim 1. As argued above, the Applicant’s features are not taught or suggested in the prior art references, and their combination is deficient in teaching or suggesting all the claim limitations.

Therefore, the cited references, separately or in combination, fail to render obvious the claimed invention, because at least one of the above-identified criteria is not met. The claimed invention, according to claim 1, is thus distinguishable over the cited references.

Furthermore, nowhere does Kostreski teach or suggest Applicant’s feature of “at least one object that includes executable code” as now recited in claim 1. Clearly, Wasilewski is deficient in teaching this feature, as acknowledged in the BPAI decision of September 30, 2004. See page 11 of the decision, for example.

In the paragraph 13 of the Office Action, the examiner merely referred to the previous

argument of claims 1, 3, 5 and 7 and completely dismissed the limitation of claim 9 (now canceled and incorporated into independent claims). Applicant's representative respectfully submits that nowhere does Kostreski teach or suggest this feature of the Applicant's invention.

If the examiner still believes otherwise and maintains the rejection based on the same prior art rejections, he is respectfully requested 1) to **specifically point out** where such a disclosure can be found in Kostreski; 2) to provide an affidavit stating facts within his personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Kostreski can't be supported by the record.

At least for the above reasons, Applicant submits that the rejection of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

Analysis of independent claims 3, 5 and 7 is analogous to the one of claim 1, as presented hereinabove. To avoid repetition, claims 3, 5 and 7 will not be discussed in detail with the understanding that they are patentable at least for the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection and allowance of claims 3, 5 and 7.

Claims 2, 4, 6, 8 and 10-13 depend from independent claims, which have been shown to be allowable over the prior art references. Accordingly, claims 2, 4, 6, 8 and 10-13 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 2, 4, 6, 8 and 10-13 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

Disposition of claim 12 was omitted by the examiner in the Office Action. It is assumed that claim 12 was rejected under 35 USC 103(a) over Wasilewski in view of Kostreski. Clarification and/or confirmation is requested.

With respect to claim 14, the examiner merely relied on Cobbley (US Patent 5,614,940) for the proposition of versions. Since the examiner did not rely on Cobbley to cure the deficiencies of Wasilewski/Kostreski in claim 1 and without conceding any statements or waiving any arguments in the Office Action concerning claim 14, it is respectfully submitted that claim 14 is allowable at least by virtue of its dependency from claim 1. Applicant submits that the reason for the rejection of claim 14 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claim.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited. However, if for any reason this application is not considered to be in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the number listed below prior to issuing a further Action.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

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December 19, 2006